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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,412	01/24/2006	Urs Burckhardt	122514	5553
25944	7590	03/23/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 03/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/522,412

Applicant(s)

BURCKHARDT, URS

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/06</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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1. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims 1, 12, and 13 recite "obtainable" regarding polymeric moieties which are of an imprecisely known structure. It would require undue experimentation for the skilled artisan to determine all of the compounds made by other processes which are encompassed by the instant claims. "Obtained" is acceptable.

The following are supporting descisions for rejecting "obtainable" and similar terms as indefinite.

1. Atlantic Thermoplastics Co. Inc. v Faytex Corp. 23 USPQ 2nd 1481 (1486).

In footnote 6, on page 1486, referring to *Cochrane v Badische Aniline and Soda Fabrik* (BASF), 11 US 293, the court stated "...because artificial alizarine can take different forms, BASF's claim would be indefinite unless limited to the described process".

The claim referred to is

"Artificial alizarine produced form anthracene or its derivatives by either of the methods described herein or any other method producing a like result."

2. Ex parte Tanksley 26 USPQ 2nd 1389

"A claim is indefinite if undue experimetnation is involved to determine boundaries of protection".

This rationale is applicable to polymers obtainable by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer produced. One who made or used a polymer made by a process other than the process recited in

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the claim would have to produce polymers using all possible parameters within the scope of the claims (temperature, pressure, diluents, component ratios, feed ratios, etc.) and then extensively analyze each product, to determine if his polymer was obtainable by a process within the claimed process.

3. *Purdue Research v Watson* 1959 CD 124 (Dist Ct) affirmed by CCPA 120 USPQ 521.

"Preparable by" was held to not particularly point out and distinctly claim the invention.

"When one has produced a composition of matter where it is not possible to define its characteristics which make it inventive except by reference to the process by which it is produced, one is permitted to so claim the composition produced by the process referred to in the claims. When the composition is thus claimed in terms of the process of its preparation, the product cannot be defined in such a manner as to assert a monopoly on the product by whatever means produced.

B. , A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948);

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and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1, 2, 3, 7, 11, and 12 recite the broad recitations which are followed by narrower recitations denoted by the language “preferably”, “if desired”, “in particular”, and/or “especially”.

C. The instant claims 1-26 recite “if desired” numerous times. It is unclear how the skilled artisan is to determine if the recited limitation is desired or not.

D. The instant claim 11 recites tradenames. The manufacturer is under no obligation to continue making these tradenamed compositions nor to maintain the same thing as the recited tradenames. Any change in availability or identity of these tradenames will render the claims meaningless. See MPEP 608.01(v) [R-2] Trademarks and Names Used in Trade.

E. The instant claims 1, 3, 11, 12, 13, 17, and 18 recite “in particular” with regard to many limitations. It is unclear if these limitations are required or are optional.

F. The instant claim 6 is unclear in that it is unclear what is to be catalyzed by DMC to give the claimed polyol. Furthermore, it is unclear what is intended by “DMC” because it is not defined in the specification.

G. Claim 19 provides for the use of the claimed composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 19 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex*

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*parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents, does not reasonably provide enablement for all of the encompassed substituents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claims recite "substituted" without specifying what the substituents are. There are an infinite number of potential substituents many of which are not expected to function according to the instantly claimed invention. It would require undue experimentation to determine how to employ each of these substituents and to determine whether or not they will function in the instantly claimed invention.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10501074. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the instant claims differ somewhat in scope, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to practice the instant claims from the claims of the copending application because they overlap so much in scope. See copending claims 4-6 in particular.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10501078501078 in view of EP 477060 A1 Piestert et al., EP 469751 A1 Aoki et al., US Pat. No. 4469831 Bueltjer et al., US Pat. No. 4853454 Merger et al., and US Pat. No. 5116931 Reisch et al..

The copending claims encompass the instantly claimed inventions broadly. They do not recite the instantly claimed component B but the copending claim 21 encompasses using such compounds. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed component B in the composition of the copending claims because it is encompassed by the copending claim 21 and Piestert shows such water containing compositions to be known for use in such curable compositions and the benefits disclosed by Piestert would have been expected in the copending claimed inventions. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the

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instantly claimed polyaldimines as the polyaldimines of the copending claims because they are encompassed by copending claim 11 and because such aldimines are well known for use in moisture cured polyurethane adhesive/sealants as shown by Aoki, the entire document particularly the aryl aldehyde aldimines which fall within the scope of the instantly claimed polyaldimines of claims 1 and 3, Bueltjer et al., the abstract and entire document which falls within the scope of the aldimines of the instant claims 1-2 and 4-6 and Merger et al., the entire document, particularly column 3, line 59 to column 4, line 10 which falls within the scope of the instant claims 4-6 where R sub 3 is the ester moiety and the attending moieties are those of the instant claims and they would have been expected to contribute their inherent curing properties to the compositions of the copending claims which encompass the use of such blocked amine curing agents.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use DMC to catalyze the polyethers of the prepolymers discussed above because this reduces production of monol, i.e. reduces unsaturation, which gives less chain termination and therefore raises the molecular weights and the modulus and the attending properties related to modulus and molecular weight. This is well known in the art at this point and is shown by Reisch et al.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 477060 A1 Piestert et al. in view of EP 469751 A1 Aoki et al., US Pat. No. 4469831 Buelter et al., US Pat. No. 4853454 Merger et al., and US Pat. No. 5116931 Reisch et al..

Piestert discloses the instantly claimed compositions and their use as sealants and adhesives at the abstract; page 2, lines 1-58, particularly 1-5, 13-16; page 3, lines 1-58, particularly 10-15 and 52-58; page 4, lines 1-58; and the remainder of the reference. The patentee is silent regarding the nature of the chemical nature of the blocking agents of page 3, lines 10-15. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed aldehyde blocked polyaldimines as the blocked polyamines of Piestert because such aldimines are well known for use in moisture cured polyurethane adhesive/sealants as shown by Aoki, the entire document particularly the aryl aldehyde aldimines which fall within the scope of the instantly claimed polyaldimines of the instant claims, Buelter et al., the abstract and entire document which falls within the scope of the aldimines of the instant claims and Merger et al., the entire document, particularly column 3, line 59 to column 4, line 10 which falls within the scope of the instant claims where R sub 3 is the ester moiety and the attending moieties are those of the instant claims and they would have been expected to contribute their inherent curing properties to the compositions of Piester which encompasses the use of such blocked amine curing agents.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use DMC to catalyze the polyethers of the prepolymers discussed above because this reduces production of monol, i.e. reduces unsaturation, which gives less chain termination and

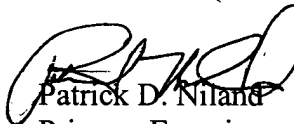
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therefore raises the molecular weights and the modulus and the attending properties related to modulus and molecular weight. This is well known in the art at this point and is shown by Resich et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrick D. Niland  
Primary Examiner  
Art Unit 1714